THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte NAOKI KOYAMA, YOSHIHIRO HAMAKAWA, ISAMU YUITOO, KANJI KAWAKAMI, KAZUO SHIIKI, MASAHIRO KITADA

_____

Appeal No. 96-0775
Application 07/990,769[1]

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ON BRIEF

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Before THOMAS, HAIRSTON and BARRETT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2, 3, 9 and 10. In an Amendment After Final (Paper Number 13), claims 2, 3, 9 and 10 were amended.

[1] Application for patent filed December 15, 1992.

The disclosed invention is described as a magnetoresistive read head 1 and an inductive write head 5 superimposed on each other to form an inductive-write, magnetoresistive-read type magnetic head. According to appellants, the coincidence between a magnetic center (A or B) of the read head 1 and a physical track width center F of the write head 5 is improved by selecting a magnetization direction of magnetoresistive element 4 so that an alignment offset amount b defined between the physical center F of the write head 5 and a physical center C of the read head 1 can be either smaller than or larger than an offset amount a defined between the magnetic center (A or B) of the read head 1 and the physical center C of the read head 1. As a result of the selection of the magnetization direction, the physical center of the write head is positioned between the magnetic center of the read head and the physical center of the read head (claims 2 and 9), or the magnetic center of the read head is positioned between the physical center of the write head and the physical center of the read head (claims 3 and 10).

Claims 2 and 10 are illustrative of the claimed invention, and they read as follows:

2. An inductive-write, magnetoresistive-read type magnetic head including a magnetoresistive read head and an inductive write head superimposed on each other, wherein a position of a magnetic center of said read head is set prior to write

operations to improve coincidence between a magnetic center of said read head and a physical center of said write head by selecting a magnetization direction of a magnetoresistive element such that an alignment offset amount defined between a physical track width center of said write head and that of said read head is smaller than an offset amount defined between the magnetic center of said read head and a physical track width center of said read head, and such that said read head and said write head are positioned so that the physical track width center of said write head is positioned between the magnetic center of said read head and the physical track width center of said read head.

10. An inductive-write, magnetoresistive-read type magnetic head including a magnetoresistive read head and an inductive write head superimposed on each other, wherein a position of a magnetic center of said read head is set prior to write operations using a transverse bias field applied to a magnetoresistive element to change a magnetization direction of said magnetoresistive element to improve coincidence between a magnetic center of said read head and a physical center of said write head such that an alignment offset amount defined between a physical track width center of said write head and that of said read head is larger than an offset amount defined between the magnetic center of said read head and a physical track width center of said read head, and such that said read head and said write head are positioned so that the magnetic center of said read head is positioned between the physical track width center of said write head and the physical track width center of said read head.

The references relied on by the examiner are:

Mowry	4,967,298	Oct. 30, 1990
Tanabe et al. (Tanabe)	5,218,497	June 8, 1993 (filed Nov. 30, 1989)

Claims 2, 3, 9 and 10 stand rejected under the first paragraph of 35 U.S.C. § 112 as failing to provide an enabling disclosure.

Claims 2, 3, 9 and 10 stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by Mowry.

Claims 2, 3, 9 and 10 stand rejected under 35 U.S.C. § 102(b)[2] as being anticipated by Tanabe.

Reference is made to the brief and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse all of the rejections.

The enablement clause of the first paragraph of 35 U.S.C. § 112 merely requires that the disclosure adequately describe the claimed invention so that the artisan could practice it without undue experimentation. See Genentech Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1364, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997). We have reviewed the grounds (Answer, pages 3 through 5) for finding lack of enablement, and we are not convinced that the skilled artisan would have to resort to undue experimentation to arrive at the claimed invention. Turning to ground number 1, the answer to the alignment precision question posed by the examiner is yes, but what does this have to do with the claimed invention. In ground number 2, the answer to the question posed therein is also

[2] In view of the date of the Tanabe patent, the rejection is assumed to be made under paragraph (e) of 35 U.S.C. § 102.

yes, but the question, as well as the answer, have little or no relevance to the claimed invention. The answer to the question in ground number 3 is probably yes, but again the answer is not relevant to the specifically claimed invention before us on appeal. In ground number 4, a permanent magnet[3] may not be the most appropriate transverse bias source if a variable bias source is needed for appellants' disclosed and claimed invention. On the other hand, the other bias sources disclosed by appellants are assumed to be appropriate bias sources for the disclosed and claimed invention. In ground number 5, we likewise fail to see the relevance of the shielding[4] question to the claimed invention. Thus, the examiner has not provided a convincing case that the disclosed and claimed invention is not enabled. The lack of enablement rejection of claims 2, 3, 9 and 10 is reversed.

Turning to the prior art rejections under 35 U.S.C. § 102(b), the examiner indicates (Answer, pages 5 through 7) that Mowry and Tanabe both disclose magnetic heads which include an

[3] See column 2, lines 26 through 33 of Mowry, and column 9, lines 16 through 48 of Tanabe for the use of permanent magnet bias sources in connection with magnetoresistive heads.

[4] Figure 1A of the drawing shows a magnetic shield at reference numeral 2. A brief discussion of a shield can be found at column 3, lines 36 through 39 of Mowry.

inductive write head and a magnetoresistive read head which includes biasing means. It is the examiner's position that the magnetic heads of both Mowry and Tanabe "will inherently exhibit the claimed read head magnetic center, read head physical center, and write head physical center positional relationships" during the operation of the magnetic heads. It is appellants' belief (Brief, page 15) that:

> [A]n accidental achievement of a product or process does not constitute proper anticipation. A true accident is never fully understood and gives no assurance that the same result can be achieved by others at a later time (emphasis in original).

The bias sources in Mowry and Tanabe will indeed move a read head and a write head with respect to each other, but the specifically claimed offset amounts and positional relationships certainly "cannot be said to be 'the natural result flowing from the operation as taught'" in each of the references. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Accordingly, we agree with appellants that inherency may not be established by probabilities or possibilities. The anticipation rejections of claims 2, 3, 9 and 10 based upon Mowry and Tanabe are reversed.

DECISION

The decision of the examiner rejecting claims 2, 3, 9 and 10 under the first paragraph of 35 U.S.C. § 112 and 35 U.S.C. § 102(b) is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)
KENNETH W. HAIRSTON Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
LEE E.BARRETT Administrative Patent Judge	)

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